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|----------------------------------|---|----------------------|
| In re Application of | : | |
| Son et al. | : | |
| Application No. 10/722812 | : | DECISION ON PETITION |
| Filed: 11/26/2003 | : | UNDER 37 CFR 1.55(c) |
| Attorney Docket No. 29137.051.00 | : | |

This is a decision on the petition under 37 CFR § 1.55(c) for an unintentionally delayed foreign priority claim, filed March 10, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of priority to the filing date of foreign Korean Patent Application Nos. 2000-82085, filed December 26, 2000, and 1999-067746, filed December 31, 1999.

The petition is **DISMISSED**.

This application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, **and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6))**;
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional (the Director

- may require additional information where there is a question whether the delay was unintentional); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The petition fails to comply with items (2) and (5) above.

As to item (2), a review of the file record fails to disclose that the priority information was included in an oath or declaration or in an Application Data Sheet (ADS) in accordance with 37 CFR 1.76(b)(6). Applicant filed an Amendment to the Specification with the present petition, to amend the application to include the priority claim to the foreign application; however, an amendment to the first line of the specification following the title is only applicable to a petition to accept a delayed priority claim under 37 CFR 1.78 (a)(3) and (a)(6). Unless provided in an ADS, 37 CFR 1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent (or inventor's certificate) for which priority is claimed under 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. *Note* MPEP 201.14.

As to item (5), the present application was filed November 26, 2003, which is more than one year before both Korean Application No. 2000-82085, filed December 26, 2000, and Korean Application No. 1999-067746, filed December 31, 1999. Therefore, the provisions of 37 CFR 1.55(c) are not available to Applicant for the above-identified applications. If there are intervening applications that would satisfy the requirements of the statute so that priority may be claimed to the above-identified Korean applications, then priority to such applications must also be claimed.

It is also noted that the amendment to add the above-noted, prior-filed applications on page one following the first sentence of the specification improperly incorporates by reference the prior-filed Korean Patent Application Nos. 2000-82085, filed December 26, 2000, and 1999-067746, filed December 31, 1999. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a). "When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application, unless an incorporation by reference statement of the prior application was presented upon filing of the application." *See Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP § 201.11 (III).

Finally, the amendment includes an incorrect filing date for Korean Patent Application Nos. 2000-82085. The amendment incorrectly states the filing date as December 26, 20009.

In view of the above, compliance with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6) must be satisfied if applicant desires to claim priority to the foreign application noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."


Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Derek Woods at (571) 272-3232.



Anthony Knight
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